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REMARKS

This Amendment is submitted in response to the Office Action mailed on November 24, 2008. Claims 1 - 5, 7 - 13, and 15 - 21 are pending, and all stand rejected at present. Claims 6, 11, 14, and 15 have been cancelled.

Support for content which was added to the claims is found in the Specification at the locations listed below and others. Support is also indicated by the parentheticals added to the claims, which identify items in the drawings, which items are described in the Specification. For example, "transaction listings (22)" in claim 1(b) indicates that item 22 in the Figures supports the term "transaction listings."

| Claim Content | Location of Support |
|--------------------------|--|
| Paper account statement | Statement 18, Figure 4; page 4, line 27. |
| Printing image on paper. | <u>Ibid.</u> |

In this connection, regarding the claim language of printing on "paper," Applicant points out that the Specification, page 1, line 25 et seq., states that in the prior art, "printing" "receipts" requires that the ATM be supplied with paper. Also, the "printing" creates paper receipts, which customers may discard and thereby cause "litter problems."

As to the invention, the Specification, page 5, lines 13, 14,

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states that the "receipt images 20" are "printed out" "in the user's monthly statement." Plainly, "printing out" refers to printing **on paper**.

RESPONSE TO 101 - REJECTIONS

In response to the 101 - rejection, claims 1 and 13 have been amended.

RESPONSE TO OBVIOUSNESS REJECTIONS

All claims were rejected as obvious, based on Shannon.

Shannon Reference

Description of Reference

Shannon allows a customer to undertake a transaction at a POS, Point of Sale terminal, as by purchasing merchandise at a retail store and using a credit card as payment. (Paragraph 16.) Shannon gives the customer the option of obtaining a printed receipt. (Paragraph 19.)

Irrespective of whether a printed receipt is generated, Shannon's POS electronically transmits data contained in the receipt to a central archive, where it is kept for a time period. (Paragraphs 27, 28.)

If the customer wishes to obtain a copy of the receipt, the customer contacts the archive through the customer's computer, by

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"going on-line," and makes a request. Receipt-data is then sent to the customer electronically. (Paragraph 32.) If a printer is present at the site where the customer is located, that receipt-data can be printed.

Shannon states that a "retrieval application 235" is required to obtain the copy of the receipt. He says that this "application" can run on a PC, PDA, cell phone, or an ATM. (Paragraphs 32, 33.)

Significant Features of Shannon

Several significant features of Shannon are the following.

ONE. The customer must make a **request** to obtain a copy of the receipt. The copies are not sent to the customer automatically.

TWO. The POS where the transaction occurred is equipped with a printer, so that, if the customer wished, he could obtain a paper receipt there.

THREE. The data transmitted by the POS to the archive is text-type data, and limited in amount. Shannon touts this as a benefit, compared with a prior-art approach wherein a paper receipt is scanned at a POS, and then transmitted as a bitmap. He asserts that the bitmap requires about 30 times the amount of data as the text data: 10,000 bytes for the former, vs 300 bytes for the latter. (Paragraphs 45 and 46.)

FOUR. When a copy of the receipt is to be created, the text-

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type data is recovered, and additional information may be added to the receipt. (Paragraphs 29 and 38.) However, this recovery is not done at the ATM of Shannon's paragraph 33. It is done prior to storage in the archive 226 and 226A.

That is, those archives store **complete replicas** of the receipts, which are constructed partially from the text-type data transmitted in Shannon.

FIVE. As explained above, a "retrieval application 235" is required to obtain the copy of the receipt. This "application" runs on a device in the possession of the customer who is requesting the receipt-data.

Application of Shannon to Claims

Claim 1

Amended claim 1 recites:

- b) for each of said transactions, printing an image (20) of a receipt using respective receipt information, such that the printing comprises adding said image (20) to a paper document (18); and
- c) including the receipt images (20) in monthly customer bank or account statements (18) sent to the users.

Point 1

Applicant points out that, in claim 1(b), the "printing" uses "receipt information." Under claim 1(a), that "receipt

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information" was sent to a "host." The claim has been amended to emphasize these facts, and also to state that the "host" induces the "printing." To repeat:

- "receipt information" is sent to a "host;"
- the "host" induces the "printing" of "receipt images;"
- the "printing" uses the "receipt information;"
- the "receipt images" are included in monthly statements sent to customers.

Further, under other sections of the claim,

- the "host" "controls" the ATM, and
- the "host" is "controlled" by a bank.

That overall operation is not found in Shannon.

Shannon's customers can download receipt-data, if they want to, and then print the receipt-data onto paper. That is completely different.

Consequently, Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify the following claim elements in Shannon:

- The bank.
- The ATM.
- The bank's control of the ATM.
- The receipt information.

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- The receipt images.
- The inducing of printing by the host.
- The monthly statements.

Point 2

The Office Action relies on several **different** operations in Shannon to show claim 1(b).

-- It relies on paragraph 17, which states that an electronic record of a purchase by a customer at a POS is generated, in addition to a paper "receipt."

However, that does not show the claimed "printing." The claimed "printing" does not cover a paper receipt given to a customer at a time of a purchase.

-- It relies on paragraphs 29 - 33, which state that

- (1) electronic text-type data needed for a receipt is generated and archived,
- (2) a customer can request that data, and
- (3) the customer can print the receipt himself.

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However, again, the cited paragraphs in Shannon do not show claim 1(b). Claim 1(b) states that

- "receipt information" is used to print the
"images;"
- the "receipt information" was received by
a "host," and
- the "host" induced the printing.

This operation is not found in Shannon. In Shannon, no "host" induces the printing. In Shannon, the customer decides whether to print the receipt or not.

Therefore, the three operations of claim 1(b) are not found in Shannon.

Point 3

Claim 1(c) recites:

- c) including the receipt images (20) in
monthly customer bank or account statements
(18) sent to the users.

The Office Action cites Shannon's paragraphs 31 - 33 to show this. However, those paragraphs merely state that a customer can request an electronic copy of data relating to customer purchases, which data is kept in storage.

Those paragraphs **do not** state that anybody includes "receipt images" included in paper statements sent to customers.

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Claim 1(c) is not found in Shannon.

Point 4

The Office Action, page 4, states:

. . . note that a customer [in Shannon] may request the printing of a monthly statement and associated receipts.

The Office Action cites Shannon's paragraphs 31 - 33 in support of this statement.

POINT 4A

Applicant points out that the Office Action is apparently relying on paragraph 32 of Shannon. That paragraph merely states that a customer may search for "statements" and download them. The customer may then print the statements.

But that does not show claim 1. Claim 1 states that receipts are added "to a paper document (18) which contains transaction listings." That is not found when Shannon's customer prints out data which the customer downloads.

For that claim recitation (taken in isolation) to be found in Shannon, as a minimum, Shannon must add the receipts to the printed document of a monthly statement, which statement contains "transaction listings." That is not seen in Shannon.

Therefore, claim 1, in simple terms, states that the receipt-

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images are printed on the monthly bill. In contrast, Shannon says that a customer can download and print out both statements and receipts. The latter does not show claim 1.

POINT 4B

Claim 1(c) states that the receipt "images" are included in paper monthly statements which are sent to customers.

In Shannon, again, a customer downloads data and prints it. That process does not show claim 1(c). Where are the paper monthly statements which are sent to customers ? Where is the "host" which induces the printing ?

POINT 4C

Applicant points out that the Office Action's statement does not show any claim recitation. The claim does not recite that a customer may request receipts or statements, as in Shannon.

POINT 4D

This statement by the Office Action is actually misleading. It compresses overall events in Shannon into a shorthand statement which is technically incorrect.

That is, in Shannon, a customer may **FIRST** request download of electronic data which represents a monthly statement or POS receipts or both.

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THEN the customer may print paper hard copy, using his own printer.

Thus, **TWO OPERATIONS** are required: (1) download and (2) printing. That does not correspond to the Office Action's statement, which is "a customer [in Shannon] may request the printing of a monthly statement and associated receipts."

To repeat: in Shannon, the customer may "request" a download of data. That is not a request for printing.

Then, the customer may use his own printer to print hard copies. Even if a "request" for printing is present here, that corresponds to nothing in the claim.

From another point of view, in Shannon, when the customer prints the hard copy, the customer is printing out his own data, namely, data which is in his possession and which is his property. It is incorrect to say that the "customer [in Shannon] may request the printing of a monthly statement and . . . receipts" in this context. The primary reason is that the statement **implies** that the "request" by the customer results in printing which corresponds to the claimed printing. That is not so.

This is elaborated in Point 4E.

POINT 4E

The Office Action states: "a customer [in Shannon] may request the printing of a monthly statement and associated receipts."

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This is a generalization of Shannon. The purpose of the generalization is to assert that Shannon accomplishes what the claims accomplish, namely, get paper receipts into the hands of a customer.

But that is not the test. The question is whether Shannon **shows the claim recitations**. The question **IS NOT** whether Shannon achieves a similar result as the claims.

Applicant repeats what happens in Shannon.

-- First, Shannon's customer downloads data, which may contain monthly statements and associated receipts.

-- Second, the customer prints out the data.

But claim 1 does not recite the first step.

Nor does claim 1 recite the second step.

The facts that the customer ends up with paper receipts in both claim 1 and Shannon is irrelevant.

The question is whether Shannon shows the claim recitations.

POINT 4F

The Office Action states: "a customer [in Shannon] may request the printing of a monthly statement and associated receipts."

As explained above, a "retrieval application 235" is required in Shannon to obtain the copy of the receipt. This "application" runs on a device in the possession of the customer who is

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requesting the receipt-data.

Therefore, the Office Action's statement actually is "a customer [in Shannon] may request the printing of a monthly statement and associated receipts by using a retrieval application on the customer's equipment, which is required in Shannon."

That shows nothing in Applicant's claims.

Point 5

From another point of view, any "request" for "printing" by a "customer" in Shannon is given **to the customer's own printer** (or to the computer controlling the printer).

The claim states that "printing" is induced by a "host."

Point 6

The claim states that the "image" which is "printed" is added to a document which contains "transaction listings."

Even if a customer in Shannon prints a receipt on his own printer, that claim recitation is not seen.

Point 7

The Office Action admits that Shannon fails to show the claimed "host." The Office Action (page 5) then concludes that Shannon inherently shows a "host."

However, several problems exist in the Office Action.

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PROBLEM 1

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a **basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

The Office Action has failed to show the "basis in fact and/or technical reasoning" as required by this MPEP section.

PROBLEM 2

At best, the Office Action has asserted that some type of host is implied by the fact that Shannon discusses a banking network.

However, that does not show the actions which the **claimed** host performs, namely

- 1) receiving the "receipt information,"
- 2) inducing printing of the "images" "using" "receipt information,"
- 3) inducing printing of the "images" on documents which contain "transaction listings."

The claimed operation of the "host" has not been shown in

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Shannon. MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

PROBLEM 3

Another way to view the PROBLEMs listed above is the following. The Office Action, in essence, has merely asserted that a "host" is present somewhere in Shannon.

That is insufficient to show the claimed host, together with the recited operations of that host.

Point 8

The claim recites an ATM. Shannon shows a POS, Point of Sale terminal.

The Office Action, page 4, asserts that paragraph 36 of Shannon shows equivalence between a POS in New Zealand and an ATM in the United States.

However, at least two problems exist in this assertion.

PROBLEM 1

MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere

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fact that the components at issue are functional or mechanical equivalents.

No showing has been made that the equivalency is recognized in the prior art.

PROBLEM 2

The cited paragraph 36 in Shannon does not say that a POS in New Zealand is equivalent to an ATM.

The cited paragraph 36 merely states that banking networks, or other networks, can be used to transfer the data in question from its storage location in a bank's archive.

Cited paragraph 36 does not state that a POS is equivalent to an ATM.

Therefore, the claimed ATM has not been shown in the applied references.

The Office Action's assertion that Shannon says a POS in New Zealand is equivalent to an ATM has not been substantiated.

Point 9

Claim 1(c) states that the receipts are included in paper statements which are sent to customers. Shannon fails to show that. As explained above, in Shannon, a customer prints his own paper receipts, if he wants to.

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Point 10

SUMMARY

The rejection is actually an **anticipation** rejection. That requires Shannon to **infringe** the claims. Shannon does not infringe.

DETAILED DISCUSSION

The rejection is asserted to be obviousness-type. However, a **single reference** is being used to reject all claims.

That is, page 4 of the Office Action admits that Shannon fails to "explicitly teach a host terminal." The same page states that Shannon "suggests" a "host terminal."

The Office Action is actually applying the test for anticipation set forth by MPEP § 2131, which states:

A claim is anticipated only if each and every element . . . is found, either expressly or **inherently described**, in a **SINGLE** prior art reference. (Citation.)

Thus, the rejection is actually an **anticipation** rejection.

It is axiomatic that, for Shannon to **anticipate** claim 1, Shannon must **infringe** claim 1. (See PATENTS, A Treatise on the Law of Patentability, Validity, and Infringement, by D. Chisum, section 3.02[1], entitled, "The Classic Infringement Test.")

Plainly, Shannon fails to infringe claim 1. Where are the

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claim elements, as enumerated in Point 1, above ?

Conclusion as to Claim 1

Numerous claim elements are not found in the cited references.

Other Independent Claims

The discussion of claim 1 applies to the other independent claims, namely, claims 7, 12, and 13.

Response to Rejection of Claims 16 - 21

Claims 16, 18, and 20

The Office Action, page 15, states that Shannon "does not explicitly teach [that] the ATM prints no receipts for customers."

The Office Action then cites Duncan, which sometimes prints receipts and sometimes does not.

Applicant points out that Duncan does not show the claim recitation. The mere fact that Duncan **sometimes** does not print receipts is insufficient to show the claim recitation.

By analogy, assume a person says "I do not smoke" (or, in closer analogy to claim 16, "I smoke no cigarettes." That does not mean "I **sometimes** do not smoke."

Restated, if the person smokes one cigarette per day, then the statement "I do not smoke" is a false statement, even though the person does not smoke most of the day.

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Nevertheless, in the interest of furthering prosecution, claim 16 has been amended. Duncan does not show amended claim 16.

Claims 17, 19, and 21

The discussion above applies to these claims. The printer shown in Duncan does the opposite of what these claims state.

The fact that this printer **sometimes** does not print receipts is irrelevant. The claim states that no printer is present.

Duncan shows a printer.

All of Claims 16 - 21

Applicant points out that the combination of references does not show the claim recitations in question.

The claims state that (1) the ATM "prints no receipts" or (2) the ATM "contains no printer."

Shannon, paragraph 19, states that a printer is present, which prints a "physical receipt."

Duncan shows a printer.

No reasoning has been given which suggests eliminating those printers. Further, if the printers are eliminated, then the references cannot print receipts. They are rendered inoperative.

MPEP § 2143.01, section 5, states:

The proposed modification cannot render the prior art unsatisfactory for its intended

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purpose.

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


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